

Remarks

The Examiner rejects claims 1-2 under 35 U.S.C. §103(a) as being unpatentable over Tachibana, et al., U.S. Patent No. 6,688,005 (Tachibana) in view of Becker, et al., U.S. Patent No. 4,337,563 (Becker). It is respectfully submitted that claims 1, 2 and 4-11 are patentable over the combination of Tachibana and Becker, claims 4-11 having been indicated as being patentable.

Specifically, claim 1 recites that the receiving passage has a peripheral groove on an inside periphery for receiving the secondary bearing element.

The Examiner recognizes that the receiving passage with a peripheral groove on an inside periphery is not disclosed or suggested by Tachibana, alleging, however, that such a receiving passage is disclosed in Becker. The Examiner asserts that it would have been obvious to provide such a receiving passage in Tachibana. Applicant respectfully disagrees with this assertion.

Even assuming, *arguendo*, that Becker is a pertinent reference, a *prima facie* case of obviousness has not been made.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that at least the first element of *prima facie* obviousness has not been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992 (footnote omitted) (emphasis in original)). See also In re Sernaker, 217 U.S.P.Q. 1,6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988); IU, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in Tachibana and/or Becker for their combination.

A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q.2d 130 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie case* of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* At 1301 (emphasis in original). No such evidence is presented in the Office Action. It is noted that the case law rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence that the prior art suggests the invalidating combination or references. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Office Action asserts that it would have been obvious to provide a groove on the inside periphery of the receiving passage in Tachibana for preventing the secondary element from sliding along the housing.

Firstly, preventing the secondary bearing from sliding along the housing is not an object of the present invention.

The Office Action further states that the groove would prevent the bearing from contacting other parts of the saw assembly. What parts? The bearing (30) is mounted on a guide sleeve (13) for joint movement therewith (column 5, lines 3-

4). Both are arranged in the gear housing (6) and are axially secured with bolts (12). The Office Action further states that the “groove does not prevent swinging movement of the bolt 12 since it is made of a resilient material.” Bolt 12 is not made of the resilient material and does not swing. What does this language mean?

The Office Action contains a sketch which points out a part which the bearing 30 can allegedly engage upon moving axially. However, the guide sleeve (13) would prevent the bearing (30) from moving rearwardly. The bearing (30) is mounted around the front portion of the guide sleeve (13) and has, at its front end, a radial wall (column 4, lines 56-61). The guide sleeve (13) engages this front wall (Fig. 2) and, thus, prevents the bearing from moving axially rearwardly.

It is respectfully submitted that provision of a groove in the inner wall of a gear cover (6) is unnecessary and, moreover, would be detrimental to the intended functioning of the bearing structure. It is noted that in the present invention the second bearing element does not rotate or swing.

It is further respectfully submitted that the case for obviousness has not been made.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Accordingly, it is respectfully submitted that the present invention, as defined by claim 1, is patentable over the combination of Tachibana and Becker.

Claim 2 depends on claim 1 and is also allowable.

Respectfully submitted,

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